

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 24 and 30 will have been amended and claim 33 will have been canceled. Claims 35-42 will have been submitted for consideration. Thus, claims 24-26, 28, 30-32 and 34-42 remain pending for consideration by the Examiner.

In view of the above, Applicants respectfully request reconsideration of the outstanding rejection of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided, and for the indication of the allowability of claims 28, 31 and 32 in the present application.

Turning to the merits of the action, the Examiner has rejected claims 24-26, 30, and 33-34 under 35 U.S.C § 102(e) as being anticipated by SAITO et al. (U.S. Patent No. 6,618,749).

As noted above, Applicants have amended 24 and 30, and have canceled claim 33. Thus, claims 24-26, 28, 30-32 and 34-42 remain pending for consideration. Thus, Applicants respectfully traverse the above rejection based on pending claims 24-26, 30-32 and 34-42, and will discuss the rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the invention.

Applicants' claims 24-26 and 34 relate to a server apparatus connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile

• P18051.A18

apparatus via the Internet. The server apparatus includes a memory configured to store reception capabilities regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive. The reception capabilities are distinct from the facsimile data and the receiving Internet facsimile apparatus is distinct from the server apparatus. The server apparatus includes a controller configured to receive facsimile data from the transmitting Internet facsimile apparatus. The controller transforms the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive, based on the stored reception capabilities of the receiving Internet facsimile apparatus, and transmits transformed facsimile data to the receiving Internet facsimile apparatus. Claim 30 recites a related method.

In direct contrast, SAITO et al. relates to an Internet facsimile which determines whether a received e-mail is a failure mail or a delivery status notification mail. The Internet facsimile of SAITO et al. extracts, from the received e-mail, information necessary for output when the received e-mail is determined to be the failure mail or the delivery status notification mail, converts the extracted information into facsimile data, and edits the converted data. The edited data is transmitted to a G3 facsimile via PSTN.

However, SAITO et al. does not disclose at least a memory which stores reception capabilities regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive, the reception capabilities being distinct from the facsimile data and the receiving Internet facsimile apparatus being distinct from the server apparatus containing the memory. SAITO et al. also does not disclose a server apparatus which includes, *inter alia*, a controller configured to receive facsimile data

P18051.A18

from the transmitting Internet facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving Internet facsimile apparatus.

In this regard, SAITO et al. teaches that "format conversion section 37 converts e-mail format data to facsimile data" and "here, the facsimile data refers to an image file that can be handled by a facsimile apparatus. It is an image compression file such as an MH file" (col. 4, lines 36-42). Thus, SAITO et al. teaches that it is possible to convert e-mail data to facsimile data such as an MH file by format conversion section 37 (col. 5, lines 49-57).

However, the above-noted disclosure merely defines what the term "the facsimile data" means. SAITO et al. also merely discloses converting the received e-mail data to facsimile data and transmitting the converted facsimile data to a G3 facsimile. In the above description, the receiving facsimile apparatus 16 of SAITO et al. is identified as a conventional G3 facsimile apparatus 16 (Fig. 1). The conventional G3 facsimile apparatus 16 is not connected to IFAX 14 (which the Examiner considers to be the server which includes "memory 22 and 23") via the Internet as recited in claim 24, but via PSTN 15 (Fig. 1).

Moreover, Applicants claims recite a controller configured "to transform the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive". As is quite clear from the above-noted portion of SAITO et al., format conversion section 37 does not convert one type of facsimile data to another type of facsimile data but converts e-mail format data to facsimile data. As can also

P18051.A18

clearly be seen in Fig. 3, the format conversion sections 37 receive e-mail data from the data storage 25. Additionally, neither of the inputs to the format conversion section 37 from the specific information extraction section 35 or from the document fixed message identification section 34 comprises facsimile data. Accordingly, as noted above, and as explicitly set forth at col. 4, lines 35-36, the format conversion section 37 merely converts e-mail format data to facsimile data. It does not transform facsimile data to a different type of facsimile data as recited and as required by Applicants claim. Based on this distinction alone, it is respectfully submitted that SAITO et al. contains an inappropriate and inadequate disclosure to render any of the claims in the present application anticipated under 35 U.S.C. § 102.

In addition to the above distinction, Applicants also note that the server apparatus of claim 24 is explicitly recited to be distinct from the receiving Internet facsimile apparatus and that the capability information relates to the type of facsimile data that the receiving Internet facsimile apparatus can receive. Thus, according to the teachings of the present invention, the server must contain reception capabilities regarding a distinct apparatus. Regardless of the Examiner's interpretation of the operation of the conversion section 37 regarding data conversion, clearly it does not store capability information regarding a distinct apparatus. There is also no teaching of this feature anywhere within SAITO et al. For this additional and independent reason, Applicants respectfully submit that SAITO et al. contains an inadequate and insufficient basis for the rejection of any of the claims in the present application.

In the Advisory Action mailed on February 27, 2006, the Examiner asserted that Applicants' arguments are not persuasive and directed Applicants' attention to col. 4,

P18051.A18

lines 36-42, col. 5, lines 49-57 and col. 3, line 54 through col. 4, line 42. However, neither of these portions of the SAITO et al. disclosure nor any other portion of the cited disclosure teaches, discloses nor renders obvious the transforming of received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive based on the stored reception capabilities of the receiving facsimile apparatus, the receiving facsimile apparatus being distinct from the server apparatus that stores the reception capabilities. Thus, the Examiner's comments attached to the Advisory Action as well as the Examiner's comments in the final rejection mailed on December 1, 2005, are not responsive to the distinctions being asserted.

Further, the Examiner addresses the reception capabilities being distinct from the facsimile data but does not address the transformation of received facsimile data into facsimile data that the receiving Internet facsimile apparatus can receive or the distinctness of the receiving Internet facsimile apparatus from the server apparatus which contains the memory that stores the reception capabilities.

For each of the above-noted reasons and certainly for all of the above-noted reasons, it is respectfully submitted that SAITO et al. contains a disclosure that is inadequate and insufficient to anticipate or render unpatentable any of the claims in the present application. An action to such effect is respectfully requested in due course.

In setting forth the Advisory Action, the Examiner asserts that "SAITO et al. teach where e-mail data is converted to facsimile data and where received data is transmitted from a PC to IFAX and stored in data storage 25 (col. 4, lines 36-42 and col. 5, lines 49-57) This is evidence of the reception capabilities being distinct form the facsimile data.

P18051.A18

The controller 21 is configured to receive the facsimile data from the transmitting facsimile apparatus (see col. 3, line 54 through col. 4, line 42)".

However, Applicants submit that SAITO et al. does not disclose a server apparatus connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile apparatus via the Internet. As claimed, the transmitting Internet facsimile apparatus and the receiving Internet facsimile apparatus are Internet facsimile apparatuses. Rather, SAITO et al. merely teaches a network including IFAX 11 and IFAX 14 (Fig.1 and col. 3, lines 34-47). When IFAX 11 operates as a transmitting Internet facsimile apparatus, IFAX 14 operates as a receiving Internet facsimile apparatus. When IFAX 14 operates as a transmitting facsimile apparatus, IFAX 14 operates as a receiving Internet facsimile apparatus. Thus, SAITO et al. does not disclose a server apparatus connected with IFAX 11 and IFAX 14. Similarly, if one of IFAX 11 and IFAX 14 is considered to be a server apparatus, SAITO et al. does not disclose a transmitting Internet facsimile apparatus and a receiving Internet facsimile apparatus.

As previously noted, G3FAX 16 is not an Internet facsimile apparatus and thus cannot be considered to be either the transmitting Internet facsimile apparatus or the receiving Internet facsimile apparatus nor, of course, can it be considered the server apparatus. Thus, SAITO et al. does not even disclose a server apparatus connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile apparatus via the Internet.

For the above additional reasons, Applicants submit that SAITO et al. does not disclose "a server apparatus" which stores reception capabilities regarding a type of

P18051.A18

facsimile data that the receiving Internet facsimile apparatus can receive, the reception capabilities being distinct from the facsimile data. SAITO et al. also does not disclose "a server apparatus" which includes, *inter alia*, a controller configured to receive facsimile data from the transmitting Internet facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving Internet facsimile apparatus.

By the present Response, Applicants have submitted several additional claims for consideration by the Examiner. It is respectfully submitted that each of these dependent claims (which depend from one of shown to be allowable claims 24 and 30) are clearly patentable based upon their own recitations, which are not disclosed by the SAITO et al. reference relied upon by the Examiner, as well as for their dependence from claims 24 or 30. Accordingly, consideration and an indication of the allowability of all of newly submitted claims 35-42 is respectfully requested in due course.

Thus, pending claims are clearly distinguished over SAITO et al. Therefore, it is respectfully submitted that the features recited in Applicants' claims 24, 25, 30, and 34 are not disclosed by SAITO et al. cited by the Examiner. Thus, the pending claims are clearly patentable over SAITO et al.

In the Final Rejection, the Examiner asserted that the Information Disclosure Statement filed in the present application on September 8, 2004 fails to comply with the provisions of 37 C.F.R. § 1.97, 1.98 and MPEP § 609 because "there is no English language Abstract of JP 8-18717 in the file". Applicants respectfully traverse the above refusal to consider. Further, Applicants wish to note an inconsistency in the

P18051.A18

Examiner's position. In particular, on the PTO-1449 Form returned with the Official Action of December 1, 2005, the Examiner initialed the English language Abstract as having been considered yet crossed out the Japanese document due to the alleged non-availability of the English language Abstract. This is inconsistent on its face. Thus, Applicants respectfully request that the Examiner clarify the record in the present application to indicate consideration of both the Japanese document 8-18717 and the English language Abstract thereof, both of which have been properly submitted to the U.S. Patent and Trademark Office.

Moreover, in the Information Disclosure Statement of September 9, 2004, Applicants submitted a patent family member (U.S. Patent No. 5,767,985) to YAMAMOTO which includes an English language Abstract. Yet further, the relevance of the Japanese document was discussed in the Notice of Reasons for Rejection that was attached to the Information Disclosure Statement. Applicants note that there is no independent and specific requirement for an English language Abstract in order for a foreign language document to be considered. Rather, the Japanese document should be considered based on the English language patent family member submitted as well as based on the discussion in the English language translation of the Notice of Reasons for Rejection. An indication of consideration of the JP document is respectfully requested in due course.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection, and an indication of the allowability of all the claims pending in the present application in due course.

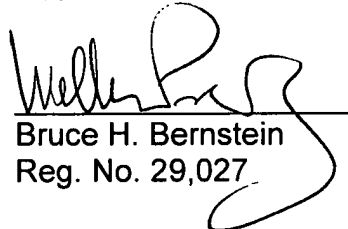
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended the rejected claims for further consideration by the Examiner. With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the pending claims with the disclosures of the cited references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The amendment to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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